

Attorney Docket No: 2006636-0050
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Sulaymann DIB-HAJJ, *et al.* Examiner: Michael PAK
Serial No.: 09/856,274 Art Unit: 1646
Filing Date: May 18, 2001 Confirmation No.: 5193
Title: Effects of GDNF and NGF on Sodium Channels in DRG Neurons

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

VIA EFS WEBFILING WWW.USPTO.GOV

Sir:

PETITION TO WITHDRAW FINALITY AND/OR REQUEST FOR PROPER ACTION

Applicant hereby respectfully requests that finality of the Office Action mailed on November 28, 2006 be withdrawn and/or that a new Office Action be issued that substantively addresses Applicant's arguments.

Section 707.07(f) of the Manual of Patent Examining Procedure ("MPEP") provides, among other things, that "Where the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it." In the present case, Applicant submitted arguments in a Response to Office Action dated September 7, 2006. The Examiner subsequently issued a Final Office Action that repeated *verbatim* each of the rejections levied in the prior Office Action yet provided absolutely no substantive response to Applicant's arguments.

The entirety of the Examiner's answer to Applicant's arguments consists of the conclusory introductory statement "Applicant's arguments filed September 7, 2005 (*sic*) have been fully considered but they are not found persuasive," coupled with the two sentence statement, placed after each rejection that "Applicants argue that administered GDNF would not inherently treat pain. However, GDNF is administered and would inherently on (*sic*) the pain associated with diabetes or other metabolic disease or neurotoxins".

Of course, Applicant's argument was not merely the *statement* that GDNF administration would not inherently treat pain. Rather, Applicant explained *why* the GDNF administration *described in the cited references* does not result in inherent treatment of pain, not the least reason being that the Examiner has provided no evidence that all subjects who received GDNF in the cited references were, in fact, suffering from pain. Applicant further demonstrated that the case law clearly *rejects* the proposition that claims to administration of an agent to treat a particular condition are inherently anticipated by administration of the agent to treat a different condition, where the subjects receiving the administration *might* have been suffering from the claimed condition.

The Examiner has not provided any substantive response to these points. For example, the Examiner has not indicated whether he believes that all subjects described in the cited references were, in fact, suffering from pain (in which case Applicant respectfully invites the Examiner to provide *evidence* of this), or whether he is challenging the legal standard articulated in the Response. Applicant respectfully submits that examination cannot progress if the Examiner does not articulate the basis for any disagreement with a submitted argument. In light of the complete absence of substantive answer from the Examiner, Applicant respectfully submits that the Finality of the Office Action mailed on November 28, 2006 was premature, and respectfully requests its withdrawal. Given the current posture of the present case, Applicant is submitting a Request for Continued Examination in order to ensure pendency of the case during consideration of this Petition. At a minimum, Applicant respectfully requests that any further Action from the Examiner respond in full to the substance of Applicant's presented arguments.

Respectfully submitted,

Dated: December 19, 2007

Choate, Hall & Stewart LLP
Patent Group
Two International Place
Boston, MA 02110

Tel: 617-248-5000
Fax: 617-248-4000

4282775_2.DOC

/BHJarrell/
Brenda Herschbach Jarrell, Ph.D.
Reg. No.: 39,223